

REMARKS

At the outset, Applicants request an interview to advance prosecution.

In the Office Action, the Examiner rejected claim 1 5-8, and 10-23 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,651,105 to Bhagwat et al. (Bhagwat) in view of U.S. Patent No. 7599370 to Leung et al. (Leung); rejected claims 2-3 under 35 U.S.C. § 103(a) as unpatentable over Bhagwat, Leung, and U.S. Patent Application Publication No. 2003/0225892 to Takusagawa et al. (Takusagawa); rejected claims 41 and 43-54 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,018,657 to Kennedy III, et al. (Kennedy) in view of Leung; and rejected claim 42 under 35 U.S.C. § 103(a) as unpatentable over Kennedy, Leung, and Takusagawa.¹

By this amendment, Applicants amend claim 1 and cancel claims 4 and 9 without prejudice or disclaimer.

Claims 1-3, 5-8, 10-23, and 41-54 are currently pending.

The Examiner rejected claim 1, 5-8, and 10-23 under 35 U.S.C. § 103(a) as unpatentable over Bhagwat in view of Leung. Applicants respectfully traverse this rejection.

The key consideration in a proper rejection under 35 U.S.C. 103(a) is not whether the pending claims can be used as a "shopping list" for searching of the prior art for descriptions of features for assembly in a manner that is allegedly similar to the claimed subject matter, but rather whether the prior art references, each taken in their entirety for all that they would reasonably teach to one of ordinary skill in the art at the

¹ Only the currently pending claims are listed.

time of the instant invention, would have rendered the instantly claimed subject matter unpatentably obvious. Unfortunately, the rejections proffered by the Office in this matter have emphasized the first approach in assembling piecemeal elements from several references to create an alleged basis for prima facie obviousness while failing to properly consider whether the cited references, when taken as a whole, properly suggest the instantly claimed subject matter in a manner that would have caused one of ordinary skill in the art at the time of the present invention to have deemed it obvious.

Claim 1 defines a method, which includes the following features:

- sending a message including information for identifying a first network access entity from a mobile entity to a second network access entity, wherein the information identifying the first network access entity comprises at least one of a network identity associated with the first network access entity, an access point name, an identity associated with an access point through which the mobile entity was connected to the first network access entity, and a link layer address of the mobile entity, wherein a global address of the first network access entity is not known to the mobile entity; and

- handing over a connection of the mobile entity from the first network access entity to the second network access entity,

- wherein the message is configured to enable the second network access entity to direct traffic to the first network access entity based on the information included in the message, wherein the information is mapped, at the second network access entity, to the global address of the first network access entity.

When a mobile node moves to a target access router, the mobile node may not know the previous access routers globally routable address. When this is the case, the mobile node may not be able to send a message, such as a fast binding update message, to the previous access router after the mobile node moves to the target access router. See, e.g., paragraph 0014 and 0015 of instant, published application. In some implementations consistent with claim 1, the target access router maps

information to the globally routable address of the previous access router, so that the fast binding update message may be sent to the globally routable address of the previous access router.

Bhagwat fails to recognize the above-noted problem with respect to the fast binding update. Bhagwat teaches that a mobile device may roam securely and seamlessly from one access point to another access point (Bhagwat, Abstract; col. 3, line 29, to col. 4, line 4). However, the Examiner acknowledges that Bhagwat fails to disclose "wherein a global address of the first network access entity is not known to the mobile entity." To cure that gap, the Examiner relies on Leung at col. 7, lines 45-50.

In particular, the Examiner states that Leung's "private address" cures the above noted deficiency of Bhagwat. Applicants disagree. Instead of what the Examiner alleges, Leung discloses mechanisms for using keep alive messages to keep private and public address mappings alive in a network address translator (NAT). Specifically, Leung discloses that when a mobile node moves to a private network, the care-of-address of the foreign agent is "private address" which is valid (and thus routable) only within the private network. The Leung foreign agent clearly has a private address, not a global address. It thus follows that Leung also fails to disclose or suggest "wherein a global address of the first network access entity is not known to the mobile entity."

In view of the foregoing, neither Bhagwat nor Leung discloses or suggests at least the following feature of claim 1: "wherein a global address of the first network access entity is not known to the mobile entity." Claim 1 is thus allowable over Bhagwat and Leung, whether taken alone or in combination, and the rejection under 35

U.S.C. § 103(a) of claim 1, as well as claims 5-8 and 10-13, at least by reason of their dependency, should be withdrawn.

In addition, for at least the reason that Bhagwat and Leung fail to disclose the "global address" as recited in claim 1, Bhagwat and Leung also fail to disclose or suggest the following feature of claim 1: "wherein the message is configured to enable the second network access entity to direct traffic to the first network access entity based on the information included in the message, wherein the information is mapped, at the second network access entity, to the global address of the first network access entity." Claim 1 is thus allowable over Bhagwat and Leung, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 1, as well as claims 5-8 and 10-13, at least by reason of their dependency, should be withdrawn for this additional reason.

Independent claim 14, although of different scope, includes the above noted feature of claim 1. For at least the reasons noted above, claim 14 is allowable over Bhagwat and Leung, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 14, as well as claims 15-23, at least by reason of their dependency, should be withdrawn.

More importantly, the Examiner's modifications of Bhagwat and Leung fundamentally change the principal of operation of those references. Specifically, the very essence of Leung is to use a keep alive messages to maintain, at the NAT, a session mapping the private address of a foreign agent and a public address of the NAT. However, inserting Leung's private address of the foreign agent into Bhagwat changes the functionality of Leung private address and likely renders Bhagwat

inoperative. Therefore, the Examiner's modification clearly run afoul of M.P.E.P. 2143.03 which states "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." Therefore, the rejection under 35 U.S.C. § 103(a) of rejected claims 1 and 5-23 should be withdrawn for this additional reason.

The Examiner rejected claims 2-3 under 35 U.S.C. § 103(a) as unpatentable over Bhagwat, Leung, and Takusagawa. Applicants respectfully traverse this rejection.

Claims 2-3 depend from claim 1 and include all the features recited therein including, among other things, "wherein a global address of the first network access entity is not known to the mobile entity." As noted above, neither Bhagwat nor Leung discloses or suggest this feature. Moreover, Takusagawa, although it discloses handovers, fails to cure the noted deficiencies of Bhagwat and Leung. Therefore, claims 2-3 are allowable over Bhagwat, Leung, and Takusagawa, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claims 2-3 should be withdrawn.

Furthermore, claim 2 recites, among other things, "wherein the message is configured as a fast binding update message." Although Takusagawa discloses a fast binding update message, Takusagawa fails to recognize how to handle not knowing the global address of the previous access router, and thus lacks the features of the "fast binding update message" recited in claim 2. Therefore, claims 2 is allowable over Bhagwat, Leung, and Takusagawa, whether taken alone or in combination, and the

rejection under 35 U.S.C. § 103(a) of claims 2 should be withdrawn for this additional reason.

The Examiner rejected claims 41 and 43-54 under 35 U.S.C. § 103(a) as unpatentable over Kennedy in view of Leung. Applicants respectfully traverse this rejection.

Claim 41 defines an apparatus, which includes the following features:

a processor, wherein the processor is configured to process data related to sending message including information to identify a first network access entity to a second network access entity, wherein a connection of the apparatus is handed over from the first network access entity to the second network access entity, the message which enables the second network access entity to direct traffic to the first network access entity, wherein a global address of the first network access entity is not known to the apparatus.

The Examiner acknowledges that Kennedy fails to disclose “wherein a global address of the first network access entity is not known to the apparatus.” To cure that gap in Kennedy, the Examiner relies on Leung. However, as noted above, Leung also lacks this feature. Therefore, claim 41 is allowable over Kennedy and Leung, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 41, as well as claims 43-44, at least by reason of their dependency, should be withdrawn.

Independent claims 45 and 49-54, although of different scope, include some of the features noted above with respect to claim 41. For at least the reasons noted above, claims 45 and 49-54 are allowable over Kennedy and Leung, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claims 45 and 49-54, as well as claims 46-48, at least by reason of their dependency, should be withdrawn.

The Examiner rejected claim 42 under 35 U.S.C. § 103(a) as unpatentable over Kennedy, Leung, and Takusagawa. Applicants respectfully traverse this rejection.

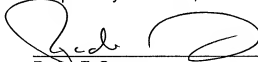
Claim 42 depends from claim 41 and include all the features recited therein including, among other things, “wherein a global address of the first network access entity is not known to the apparatus.” As noted above, neither Kennedy, Leung, nor Takusagawa discloses or suggests this noted feature. Therefore, claim 42 is allowable over Kennedy, Leung, and Takusagawa, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 42 should be withdrawn.

CONCLUSION

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Applicant is concurrently filing herewith a Petition for a one-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-601001US/NC39894US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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